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PATENT APPLICATION

ATTORNEY DOCKET NO. 200313005-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Steven S. HOMER

Confirmation No.: 7413

Application No.: 10/814,538

Examiner: Holton, Steven E.

Filing Date: March 31, 2004

Group Art Unit: 2629

Title: COMPUTER INPUT PEN APPARATUS

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on September 17, 2007.

☒ The fee for filing this Appeal Brief is \$510.00 (37 CFR 41.20).

☐ No Additional Fee Required.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
\$120

☐ 2nd Month
\$460

☐ 3rd Month
\$1050

☐ 4th Month
\$1640

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 510. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

☒ A duplicate copy of this transmittal letter is enclosed.

☐ I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
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Respectfully submitted,

Steven S. HOMER

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

Applicants: Steven S. HOMER Confirmation No.: 7413

Application Serial No.: 10/814,538

Filed: March 31, 2004

Title: COMPUTER INPUT PEN APPARATUS

Group Art Unit: 2629

Examiner: Holton, Steven E.

Docket No.: 200313005-1

MAIL STOP: APPEAL BRIEF PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

APPEAL BRIEF

Appellant has appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner mailed July 25, 2007, finally rejecting Claims 1-8 and 17-21. Appellant filed a Notice of Appeal on September 17, 2007. Appellant respectfully submit herewith this Appeal Brief with authorization to charge the statutory fee of \$510.00.

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REAL PARTY IN INTEREST

The present application was assigned to Hewlett-Packard Development Company, L.P. as indicated by an assignment from the inventor recorded on July 9, 2004 in the Assignment Records of the United States Patent and Trademark Office at Reel 014832, Frame 0930. The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Claims 1-8 and 17-21 stand rejected pursuant to a final Office Action mailed July 25, 2007 (hereinafter the "Final Office Action"). Claims 9-16 are considered allowable. Claims 1-8 and 17-21 are presented for appeal.

STATUS OF AMENDMENTS

No amendment has been filed subsequent to the mailing of the Final Office Action.

SUMMARY OF CLAIMED SUBJECT MATTER

Embodiments of the present invention as defined by independent Claim 1 are directed toward a computer input pen (10) comprising a cylindrical housing (12) and a weight (20, 50) eccentrically disposed within the cylindrical housing (12) relative to a longitudinal axis (14) of the cylindrical housing (12). The weight (20, 50) is rotationally coupled relative to the cylindrical housing (12) with a desired level of friction to absorb rotational energy of the cylindrical housing (12) relative to the weight (20, 50) (at least at page 2, lines 21-31; page 3, lines 1-32; page 4, lines 1-32; page 5, lines 1-4; and figures 1, 2A-2D, 3A and 3B).

Embodiments of the present invention as defined by Claim 2 are directed toward the invention defined by Claim 1, and further comprising a frictional element (30) disposed on a

surface of the weight (20, 50) (at least at page 3, lines 27-32; page 4, lines 1-32; page 5, lines 1-4; and figures 2B, 2C and 3A).

Embodiments of the present invention as defined by Claim 3 are directed toward the invention defined by Claim 1, and further comprising a frictional element (30) disposed on an interior surface of the cylindrical housing (12) (at least at page 4, lines 4-32; page 5, lines 1-4; and figures 2D and 3B).

Embodiments of the present invention as defined by Claim 5 are directed toward the invention defined by Claims 1 and 4, and further comprising a frictional element (30) disposed on a surface of the weight (20) relative to the shaft (22) (at least at page 3, lines 27-32; page 4, lines 1-3; and figure 2B).

Embodiments of the present invention as defined by Claim 6 are directed toward the invention defined by Claims 1 and 4, and further comprising a frictional element (30) disposed on a surface of the shaft (22) relative to the weight (20) (at least at page 3, lines 17-26; and figure 2A).

Embodiments of the present invention as defined by Claim 7 are directed toward the invention defined by Claim 1, and further comprising a frictional element (30) integrally formed on a surface of the weight (20, 50) (at least at page 3, lines 27-32; page 4, lines 1-32; page 5, lines 1-4; and figures 2B, 2C and 3A).

Embodiments of the present invention as defined by Claim 8 are directed toward the invention defined by Claim 1, and further comprising a frictional element (30) integrally formed on an interior surface of the cylindrical housing (12) (at least at page 4, lines 4-32; page 5, lines 1-4; and figures 2D and 3B).

Embodiments of the present invention as defined by independent Claim 17 are directed toward a computer input pen (10) comprising means (22, 40) for moveably and eccentrically disposing a weight (20, 50) within a cylindrical housing (12) and means (30) for providing a desired level of friction to absorb energy resulting from movement between the weight (20, 50) and the cylindrical housing (12) (at least at page 2, lines 21-31; page 3, lines 1-32; page 4, lines 1-32; page 5, lines 1-4; and figures 1, 2A-2D, 3A and 3B).

Embodiments of the present invention as defined by Claim 19 are directed toward the invention defined by Claim 17, wherein the friction means (30) comprises means (30) integrally

formed on a surface of the weight (20, 50) (at least at page 3, lines 27-32; page 4, lines 1-32; page 5, lines 1-4; and figures 2B, 2C and 3A).

Embodiments of the present invention as defined by Claim 20 are directed toward the invention defined by Claim 17, wherein the friction means (30) comprises means (30) integrally formed on an interior surface of the cylindrical housing (12) (at least at page 4, lines 4-32; page 5, lines 1-4; and figures 2D and 3B).

Embodiments of the present invention as defined by Claim 21 are directed toward the invention defined by Claim 17, wherein the friction means (30) comprises means (30) formed on a shaft (22) disposed along a longitudinal axis (14) of the cylindrical housing (12) and adapted to engage a corresponding surface of the weight (20) (at least at page 3, lines 17-26; and figure 2A).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-8 and 17-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,215,480 issued to Danis et al. (hereinafter "*Danis*").

ARGUMENT

A. Standard

1. 35 U.S.C. § 103

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991); M.P.E.P. § 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.* Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Additionally, not only must there be a suggestion to combine the functional or operational aspects of the combined references, but also the prior art is required to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 F.2d

1173, 1183 (Fed. Cir. 1991). Moreover, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000).

B. Argument

1. Rejection under 35 U.S.C. §103 in view of *Danis*

a. Claims 1 and 4

Claims 1 and 4 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Danis*. Of the rejected claims, Claim 1 is independent. Appellant respectfully submits that independent Claim 1 is patentable over *Danis* and, therefore, Claim 4 that depends from independent Claim 1 is also patentable over *Danis*.

Embodiments of the present invention are directed toward a computer input pen apparatus that is configured to inhibit and/or substantially prevent rolling of the pen even though the pen is cylindrically shaped. Thus, in some embodiments, the computer input pen apparatus (10) comprises a weight (20, 50) that is eccentrically disposed within a cylindrical housing (12) of the pen (10) and where a desired level of friction is provided relative to the weight (20, 50) to absorb any rotational energy resulting from rolling of the pen (10). Accordingly, for example, independent Claim 1 recites "a weight eccentrically disposed within [a] cylindrical housing" where the "weight [is] rotationally coupled relative to the cylindrical housing with a desired level of friction to absorb rotational energy of the cylindrical housing relative to the weight" (emphasis added).

Danis appears to disclose a cylindrical body 10 in the shape of a writing device that is directed toward displaying content over 180° of the body (such as text 17) such that as the body 10 rolls, the text scrolls (*Danis*, column 2, lines 14-35, figure 1). *Danis* appears to disclose a mouse-type rotation sensor 31 having a weighted cam 32 disposed within the body 10 of *Danis* that is used to detect the rotation or rolling of the body 10 of *Danis* (the direction and speed of such rolling movement) so that the displayed content may be correspondingly scrolled (*Danis*, column 3, lines 28-45, figure 3).

In an office action dated January 24, 2007, the Examiner stated:

[I]t would be obvious to one skilled in the art that the weighted cam would create friction with the interior walls of the pen body and absorb some of the rotational energy of the cylindrical housing relative to the weight. The friction between the cam and

the cylindrical body would then inhibit the movement of the weight and the amount of friction would be chosen so that the weight moved enough within the body to keep the display facing the desired angle as the pen body is rotated.

(page 2). In the Final Office Action, the Examiner further states:

Danis does not discuss the amount of friction between the weighted cam and the cylindrical housing; however, the amount of friction between the weight and the cylindrical housing would be set at "a desired level of friction to absorb rotational energy". The amount of friction between the housing and the weight would be selected to a desired level so that the amount of absorbed rotational energy would not inhibit the operation of the scrolling of the display text based on the rotation of the weight. The amount of friction between the cylindrical housing and the weight would be set to a relatively low desired level of friction.

(Final Office Action, pages 2 and 3). Appellant respectfully submits that Claim 1 is patentable over *Danis*.

In the Final Office Action, the Examiner appears to acknowledge that in the *Danis* device, a very low level of friction would be desired relative to the weighted cam 32 of *Danis* (Final Office Action, pages 2 and 3). In fact, it would appear that a practically negligible amount of friction would be preferred relative to the weighted cam 32 in *Danis* so that when the *Danis* device is rolled along a surface, the weighted cam 32 of *Danis* freely rotates within the housing of the *Danis* device so that an accurate determination of the amount of device roll is obtained, thereby enabling the text scrolling to correspond to the amount of device roll. Accordingly, the Examiner appears to misconstrue Claim 1 in view of *Danis*. Claim 1 recites that the "weight [is] rotationally coupled relative to the cylindrical housing with a desired level of friction to absorb rotational energy of the cylindrical housing relative to the weight" (emphasis added). In contrast, in the *Danis* device, the weighted cam would clearly be preferred to not absorb rotational energy of the rolling *Danis* device. In fact, the Examiner appears to clearly acknowledge the foregoing when the Examiner states that "[t]he amount of friction between the cylindrical housing and the weight would be set to a relatively low desired level of friction" in the *Danis* device, thereby indicating that it would clearly be desired that the weighted cam in the *Danis* device not absorb rotational energy. Also, the Examiner makes an assumption that is clearly not supported by the *Danis* reference, namely, that any level of friction would be desired in the *Danis* device relative to the weighted cam.

Further, Appellant respectfully submits that friction relative to the weighted cam 32 of *Danis* would adversely affect the displayed content of the *Danis* device. For example, friction relative to the weighted cam 32 of *Danis* would impede the rotational movement of the cam 32 within the body 10 of *Danis*, which would result in the cam 32 rotating slower than the actual rotation of the body 10 of *Danis*. Accordingly, friction relative to the cam 32 of *Danis* would adversely affect the scrolling display of the *Danis* device. Thus, even though there may be a small amount of friction inherently present relative to the weighted cam 32 of *Danis*, there is clearly not a desire to have a particular level of friction to absorb rotational energy in the *Danis* device. Therefore, *Danis* clearly teaches away from Claim 1.

Thus, not only does *Danis* not disclose, teach or even suggest the limitations of Claim 1, but *Danis* appears to clearly teach away from any "desired level of friction to absorb rotational energy" as recited by Claim 1. Accordingly, for at least these reasons, Claim 1, and Claim 4 that depends therefrom, are patentable over *Danis*.

b. Claim 2

Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Danis*. Appellant respectfully submits that Claim 2 is patentable over *Danis*.

Claim 2 recites "a frictional element disposed on a surface of the weight." In the Final Office Action, the Examiner states:

[F]riction is caused by all surfaces in contact with one another and it would be a matter of design choice for providing a frictional surface along the surface of the weight, the cylindrical housing or along the shaft supporting the weight within the pen device.

(Final Office Action, page 3). Appellant respectfully disagrees. *Danis* does not disclose or even suggest that there is any contact whatsoever between the cam 32 of *Danis* and any other portion of the *Danis* device that would even necessitate the inclusion of a frictional element on the weighted cam 32 of *Danis*. For example, Appellant respectfully refers to figure 3 of *Danis* which appears to be the only figure of *Danis* which illustrates the cam 32 of *Danis*. Figure 3 of *Danis* does not disclose or even suggest that the cam 32 of *Danis* is in any manner whatsoever in contact with an interior wall of the *Danis* device. Further, *Danis* appears to disclose a rotation sensor 31 having a shaft extending outwardly therefrom which connects to the weighted cam 32 of *Danis* (*Danis*, column 3, lines 28-46, figure 3). Appellant presumes that for the rotation sensor 31 to accurately read the rotation of the *Danis* device, the weighted cam 32 must be

fixedly coupled to the connecting shaft. Accordingly, not only does *Danis* not disclose or even suggest the inclusion of a friction element on the weighted cam of *Danis*, but there is clearly no reason to include a friction element on the weighted cam of *Danis*. In fact, as discussed above in connection with Claim 1, *Danis* clearly teaches away from including a friction element on the weighted cam of *Danis* at least because the friction would adversely affect the scrolling display of the *Danis* device because of the inhibited rotation of the weighted cam 32 of *Danis* within the *Danis* device. Therefore, for at least these reasons, Appellant respectfully submits that Claim 2 is patentable over *Danis*.

c. Claim 3

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Danis*. Appellant respectfully submits that Claim 3 is patentable over *Danis*.

Claim 3 recites "a frictional element disposed on an interior surface of the cylindrical housing." In the Final Office Action, the Examiner states:

[F]riction is caused by all surfaces in contact with one another and it would be a matter of design choice for providing a frictional surface along the surface of the weight, the cylindrical housing or along the shaft supporting the weight within the pen device.

(Final Office Action, page 3). Appellant respectfully disagrees. *Danis* does not disclose or even suggest that there is any contact whatsoever between the cam 32 of *Danis* and any other portion of the *Danis* device that would even necessitate the inclusion of a frictional element on the housing of *Danis*. For example, Appellant respectfully refers to figure 3 of *Danis* which appears to be the only figure of *Danis* which illustrates the cam 32 of *Danis*. Figure 3 of *Danis* does not disclose or even suggest that the cam 32 of *Danis* is in any manner whatsoever in contact with an interior wall of the *Danis* device. Accordingly, not only does *Danis* not disclose or even suggest the inclusion of a friction element on interior wall of the *Danis* housing, but there is clearly no reason to include a friction element on the interior wall of the *Danis* housing. In fact, as discussed above in connection with Claim 1, *Danis* clearly teaches away from including a friction element on the interior wall of the *Danis* housing at least because the friction would adversely affect the scrolling display of the *Danis* device because of the inhibited rotation of the weighted cam 32 of *Danis* within the *Danis* device. Therefore, for at least these reasons, Appellant respectfully submits that Claim 3 is patentable over *Danis*.

d. Claim 5

Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Danis*. Appellant respectfully submits that Claim 5 is patentable over *Danis*.

Claim 5 recites "a frictional element disposed on a surface of the weight relative to the shaft." In the Final Office Action, the Examiner states:

[F]riction is caused by all surfaces in contact with one another and it would be a matter of design choice for providing a frictional surface along the surface of the weight, the cylindrical housing or along the shaft supporting the weight within the pen device.

(Final Office Action, page 3). Appellant respectfully disagrees. *Danis* does not disclose or even suggest that there is any contact whatsoever between the cam 32 of *Danis* and any other portion of the *Danis* device that would even necessitate the inclusion of a frictional element on the weighted cam 32 of *Danis*. For example, Appellant respectfully refers to figure 3 of *Danis* which appears to be the only figure of *Danis* which illustrates the cam 32 of *Danis*. Figure 3 of *Danis* does not disclose or even suggest that the cam 32 of *Danis* is in any manner whatsoever in contact with an interior wall of the *Danis* device. Further, *Danis* appears to disclose a rotation sensor 31 having a shaft extending outwardly therefrom which connects to the weighted cam 32 of *Danis* (*Danis*, column 3, lines 28-46, figure 3). Appellant presumes that for the rotation sensor 31 to accurately read the rotation of the *Danis* device, the weighted cam 32 must be fixedly coupled to the connecting shaft. Accordingly, not only does *Danis* not disclose or even suggest the inclusion of a friction element on the weighted cam of *Danis*, but there is clearly no reason to include a friction element on the surface of weighted cam relative to the connecting shaft of *Danis* at least because the weighted cam of *Danis* is fixedly coupled to the connecting shaft. In fact, as discussed above in connection with Claim 1, *Danis* clearly teaches away from including a friction element on the weighted cam of *Danis* at least because the friction would adversely affect the scrolling display of the *Danis* device because of the inhibited rotation of the weighted cam 32 of *Danis* within the *Danis* device. Therefore, for at least these reasons, Appellant respectfully submits that Claim 5 is patentable over *Danis*.

e. Claim 6

Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Danis*. Appellant respectfully submits that Claim 6 is patentable over *Danis*.

Claim 6 recites "a frictional element disposed on a surface of the shaft relative to the weight." In the Final Office Action, the Examiner states:

[F]riction is caused by all surfaces in contact with one another and it would be a matter of design choice for providing a frictional surface along the surface of the weight, the cylindrical housing or along the shaft supporting the weight within the pen device.

(Final Office Action, page 3). Appellant respectfully disagrees. Appellant respectfully refers to figure 3 of *Danis* which appears to be the only figure of *Danis* which illustrates the cam 32 of *Danis*. Figure 3 of *Danis* does not disclose or even suggest that the cam 32 of *Danis* is in any manner whatsoever in contact with an interior wall of the *Danis* device. Further, *Danis* appears to disclose a rotation sensor 31 having a shaft extending outwardly therefrom which connects to the weighted cam 32 of *Danis* (*Danis*, column 3, lines 28-46, figure 3). Appellant presumes that for the rotation sensor 31 to accurately read the rotation of the *Danis* device, the weighted cam 32 must be fixedly coupled to the connecting shaft. Accordingly, not only does *Danis* not disclose or even suggest the inclusion of a friction element on the connecting shaft of *Danis*, but there is clearly no reason to include a friction element on the connecting shaft relative to the weighted cam of *Danis* at least because the weighted cam of *Danis* is fixedly coupled to the connecting shaft. In fact, as discussed above in connection with Claim 1, *Danis* clearly teaches away from including a friction element on the connecting shaft at least because the friction would adversely affect the scrolling display of the *Danis* device because of the inhibited rotation of the weighted cam 32 of *Danis* within the *Danis* device. Therefore, for at least these reasons, Appellant respectfully submits that Claim 6 is patentable over *Danis*.

f. Claim 7

Claim 7 was are rejected under 35 U.S.C. §103(a) as being unpatentable over *Danis*. Appellant respectfully submits that Claim 7 is patentable over *Danis*.

Claim 7 recites "a frictional element integrally formed on a surface of the weight." In the Final Office Action, the Examiner states:

[F]riction is caused by all surfaces in contact with one another and it would be a matter of design choice for providing a frictional surface along the surface of the weight, the cylindrical housing or along the shaft supporting the weight within the pen device.

(Final Office Action, page 3). Appellant respectfully disagrees. *Danis* does not disclose or even suggest that there is any contact whatsoever between the cam 32 of *Danis* and any other

portion of the *Danis* device that would even necessitate the inclusion of a frictional element on the weighted cam 32 of *Danis*. For example, Appellant respectfully refers to figure 3 of *Danis* which appears to be the only figure of *Danis* which illustrates the cam 32 of *Danis*. Figure 3 of *Danis* does not disclose or even suggest that the cam 32 of *Danis* is in any manner whatsoever in contact with an interior wall of the *Danis* device. Further, *Danis* appears to disclose a rotation sensor 31 having a shaft extending outwardly therefrom which connects to the weighted cam 32 of *Danis* (*Danis*, column 3, lines 28-46, figure 3). Appellant presumes that for the rotation sensor 31 to accurately read the rotation of the *Danis* device, the weighted cam 32 must be fixedly coupled to the connecting shaft. Accordingly, not only does *Danis* not disclose or even suggest the inclusion of a friction element on the weighted cam of *Danis*, but there is clearly no reason to include a friction element on the weighted cam of *Danis*. In fact, as discussed above in connection with Claim 1, *Danis* clearly teaches away from including a friction element on the weighted cam of *Danis* at least because the friction would adversely affect the scrolling display of the *Danis* device because of the inhibited rotation of the weighted cam 32 of *Danis* within the *Danis* device. Therefore, for at least these reasons, Appellant respectfully submits that Claim 7 is patentable over *Danis*.

g. Claim 8

Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Danis*. Appellant respectfully submits that Claim 8 is patentable over *Danis*.

Claim 8 recites "a frictional element integrally formed on an interior surface of the cylindrical housing." In the Final Office Action, the Examiner states:

[F]riction is caused by all surfaces in contact with one another and it would be a matter of design choice for providing a frictional surface along the surface of the weight, the cylindrical housing or along the shaft supporting the weight within the pen device.

(Final Office Action, page 3). Appellant respectfully disagrees. *Danis* does not disclose or even suggest that there is any contact whatsoever between the cam 32 of *Danis* and any other portion of the *Danis* device that would even necessitate the inclusion of a frictional element on the housing of *Danis*. For example, Appellant respectfully refers to figure 3 of *Danis* which appears to be the only figure of *Danis* which illustrates the cam 32 of *Danis*. Figure 3 of *Danis* does not disclose or even suggest that the cam 32 of *Danis* is in any manner whatsoever in contact with an interior wall of the *Danis* device. Accordingly, not only does *Danis* not disclose or even suggest the inclusion of a friction element on interior wall of the *Danis* housing, but

there is clearly no reason to include a friction element on the interior wall of the *Danis* housing. In fact, as discussed above in connection with Claim 1, *Danis* clearly teaches away from including a friction element on the interior wall of the *Danis* housing at least because the friction would adversely affect the scrolling display of the *Danis* device because of the inhibited rotation of the weighted cam 32 of *Danis* within the *Danis* device. Therefore, for at least these reasons, Appellant respectfully submits that Claim 8 is patentable over *Danis*.

h. Claims 17 and 18

Claims 17 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Danis*. Of the rejected claims, Claim 17 is independent. Appellant respectfully submits that independent Claim 17 is patentable over *Danis* and, therefore, Claim 18 that depends from independent Claim 17 is also patentable over *Danis*.

Independent Claim 17 recites "means for moveably and eccentrically disposing a weight within a cylindrical housing" and "means for providing a desired level of friction to absorb energy resulting from movement between the weight and the cylindrical housing" (emphasis added). *Danis* appears to disclose a cylindrical body 10 in the shape of a writing device that is directed toward displaying content over 180° of the body (such as text 17) such that as the body 10 rolls, the text scrolls (*Danis*, column 2, lines 14-35, figure 1). *Danis* appears to disclose a mouse-type rotation sensor 31 having a weighted cam 32 disposed within the body 10 of *Danis* that is used to detect the rotation or rolling of the body 10 of *Danis* (the direction and speed of such rolling movement) so that the displayed content may be correspondingly scrolled (*Danis*, column 3, lines 28-45, figure 3).

In an office action dated January 24, 2007, the Examiner stated:

[I]t would be obvious to one skilled in the art that the weighted cam would create friction with the interior walls of the pen body and absorb some of the rotational energy of the cylindrical housing relative to the weight. The friction between the cam and the cylindrical body would then inhibit the movement of the weight and the amount of friction would be chosen so that the weight moved enough within the body to keep the display facing the desired angle as the pen body is rotated.

(page 2). In the Final Office Action, the Examiner further states:

Danis does not discuss the amount of friction between the weighted cam and the cylindrical housing; however, the amount of friction between the weight and the cylindrical housing would be set at "a desired level of friction to absorb rotational energy". The

amount of friction between the housing and the weight would be selected to a desired level so that the amount of absorbed rotational energy would not inhibit the operation of the scrolling of the display text based on the rotation of the weight. The amount of friction between the cylindrical housing and the weight would be set to a relatively low desired level of friction.

(Final Office Action, pages 2 and 3). Appellant respectfully submits that Claim 17 is patentable over *Danis*.

In the Final Office Action, the Examiner appears to acknowledge that in the *Danis* device, a very low level of friction would be desired relative to the weighted cam 32 of *Danis* (Final Office Action, pages 2 and 3). In fact, it would appear that a practically negligible amount of friction would be preferred relative to the weighted cam 32 in *Danis* so that when the *Danis* device is rolled along a surface, the weighted cam 32 of *Danis* freely rotates within the housing of the *Danis* device so that an accurate determination of the amount of device roll is obtained, thereby enabling the text scrolling to correspond to the amount of device roll. Accordingly, the Examiner appears to misconstrue Claim 17 in view of *Danis*. Claim 17 recites that "means for providing a desired level of friction to absorb energy resulting from movement between the weight and the cylindrical housing" (emphasis added). In contrast, in the *Danis* device, the weighted cam would clearly be preferred to not absorb rotational energy of the rolling *Danis* device. In fact, the Examiner appears to clearly acknowledge the foregoing when the Examiner states that "[t]he amount of friction between the cylindrical housing and the weight would be set to a relatively low desired level of friction" in the *Danis* device, thereby indicating that it would clearly be desired that the weighted cam in the *Danis* device not absorb rotational energy. Also, the Examiner makes an assumption that is clearly not supported by the *Danis* reference, namely, that any level of friction would be desired in the *Danis* device relative to the weighted cam.

Further, Appellant respectfully submits that friction relative to the weighted cam 32 of *Danis* would adversely affect the displayed content of the *Danis* device. For example, friction relative to the weighted cam 32 of *Danis* would impede the rotational movement of the cam 32 within the body 10 of *Danis*, which would result in the cam 32 rotating slower than the actual rotation of the body 10 of *Danis*. Accordingly, friction relative to the cam 32 of *Danis* would adversely affect the scrolling display of the *Danis* device. Thus, even though there may be a small amount of friction inherently present relative to the weighted cam 32 of *Danis*, there is

clearly not a desire to have a particular level of friction to absorb rotational energy in the *Danis* device. Therefore, *Danis* clearly teaches away from Claim 17.

Thus, not only does *Danis* not disclose, teach or even suggest the limitations of Claim 17, but *Danis* appears to clearly teach away from any "desired level of friction to absorb energy resulting from movement between the weight and the cylindrical housing " as recited by Claim 17. Accordingly, for at least these reasons, Claim 17, and Claim 18 that depends therefrom, are patentable over *Danis*.

i. Claim 19

Claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Danis*. Appellant respectfully submits that Claim 19 is patentable over *Danis*.

Claim 19 recites "wherein the friction means comprises means integrally formed on a surface of the weight." In the Final Office Action, the Examiner states:

[F]riction is caused by all surfaces in contact with one another and it would be a matter of design choice for providing a frictional surface along the surface of the weight, the cylindrical housing or along the shaft supporting the weight within the pen device.

(Final Office Action, page 3). Appellant respectfully disagrees. *Danis* does not disclose or even suggest that there is any contact whatsoever between the cam 32 of *Danis* and any other portion of the *Danis* device that would even necessitate the inclusion of a frictional element on the weighted cam 32 of *Danis*. For example, Appellant respectfully refers to figure 3 of *Danis* which appears to be the only figure of *Danis* which illustrates the cam 32 of *Danis*. Figure 3 of *Danis* does not disclose or even suggest that the cam 32 of *Danis* is in any manner whatsoever in contact with an interior wall of the *Danis* device. Further, *Danis* appears to disclose a rotation sensor 31 having a shaft extending outwardly therefrom which connects to the weighted cam 32 of *Danis* (*Danis*, column 3, lines 28-46, figure 3). Appellant presumes that for the rotation sensor 31 to accurately read the rotation of the *Danis* device, the weighted cam 32 must be fixedly coupled to the connecting shaft. Accordingly, not only does *Danis* not disclose or even suggest the inclusion of a friction element on the weighted cam of *Danis*, but there is clearly no reason to include a friction element on the weighted cam of *Danis*. In fact, as discussed above in connection with Claim 1, *Danis* clearly teaches away from including a friction element on the weighted cam of *Danis* at least because the friction would adversely affect the scrolling display of the *Danis* device because of the inhibited rotation of the weighted cam 32 of *Danis* within the

Danis device. Therefore, for at least these reasons, Appellant respectfully submits that Claim 19 is patentable over *Danis*.

j. Claim 20

Claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Danis*. Appellant respectfully submits that Claim 20 is patentable over *Danis*.

Claim 20 recites "wherein the friction means comprises means integrally formed on an interior surface of the cylindrical housing." In the Final Office Action, the Examiner states:

[F]riction is caused by all surfaces in contact with one another and it would be a matter of design choice for providing a frictional surface along the surface of the weight, the cylindrical housing or along the shaft supporting the weight within the pen device.

(Final Office Action, page 3). Appellant respectfully disagrees. *Danis* does not disclose or even suggest that there is any contact whatsoever between the cam 32 of *Danis* and any other portion of the *Danis* device that would even necessitate the inclusion of a frictional element on the housing of *Danis*. For example, Appellant respectfully refers to figure 3 of *Danis* which appears to be the only figure of *Danis* which illustrates the cam 32 of *Danis*. Figure 3 of *Danis* does not disclose or even suggest that the cam 32 of *Danis* is in any manner whatsoever in contact with an interior wall of the *Danis* device. Accordingly, not only does *Danis* not disclose or even suggest the inclusion of a friction element on interior wall of the *Danis* housing, but there is clearly no reason to include a friction element on the interior wall of the *Danis* housing. In fact, as discussed above in connection with Claim 1, *Danis* clearly teaches away from including a friction element on the interior wall of the *Danis* housing at least because the friction would adversely affect the scrolling display of the *Danis* device because of the inhibited rotation of the weighted cam 32 of *Danis* within the *Danis* device. Therefore, for at least these reasons, Appellant respectfully submits that Claim 20 is patentable over *Danis*.

k. Claim 21

Claim 21 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Danis*. Appellant respectfully submits that Claim 21 is patentable over *Danis*.

Claim 21 recites "wherein the friction means comprises means formed on a shaft disposed along a longitudinal axis of the cylindrical housing and adapted to engage a corresponding surface of the weight." In the Final Office Action, the Examiner states:

[F]riction is caused by all surfaces in contact with one another and it would be a matter of design choice for providing a frictional surface along the surface of the weight, the cylindrical housing or along the shaft supporting the weight within the pen device.

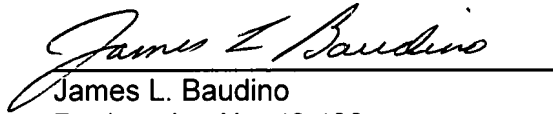
(Final Office Action, page 3). Appellant respectfully disagrees. Appellant respectfully refers to figure 3 of *Danis* which appears to be the only figure of *Danis* which illustrates the cam 32 of *Danis*. Figure 3 of *Danis* does not disclose or even suggest that the cam 32 of *Danis* is in any manner whatsoever in contact with an interior wall of the *Danis* device. Further, *Danis* appears to disclose a rotation sensor 31 having a shaft extending outwardly therefrom which connects to the weighted cam 32 of *Danis* (*Danis*, column 3, lines 28-46, figure 3). Appellant presumes that for the rotation sensor 31 to accurately read the rotation of the *Danis* device, the weighted cam 32 must be fixedly coupled to the connecting shaft. Accordingly, not only does *Danis* not disclose or even suggest the inclusion of a friction element on the connecting shaft of *Danis*, but there is clearly no reason to include a friction element on the connecting shaft relative to the weighted cam of *Danis* at least because the weighted cam of *Danis* is fixedly coupled to the connecting shaft. In fact, as discussed above in connection with Claim 1, *Danis* clearly teaches away from including a friction element on the connecting shaft at least because the friction would adversely affect the scrolling display of the *Danis* device because of the inhibited rotation of the weighted cam 32 of *Danis* within the *Danis* device. Therefore, for at least these reasons, Appellant respectfully submits that Claim 21 is patentable over *Danis*.

CONCLUSION

Appellants have demonstrated that the present invention as claimed is clearly distinguishable over the art cited of record. Therefore, Appellant(s) respectfully request the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

The Commissioner is authorized to charge the statutory fee of \$510.00 to Deposit Account No. 08-2025 of Hewlett-Packard Company. Although no other fee is believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,


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Date: November 12, 2007

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CLAIMS APPENDIX

1. A computer input pen, comprising:
a cylindrical housing; and
a weight eccentrically disposed within the cylindrical housing relative to a longitudinal axis of the cylindrical housing, the weight rotationally coupled relative to the cylindrical housing with a desired level of friction to absorb rotational energy of the cylindrical housing relative to the weight.
2. The computer input pen of Claim 1, further comprising a frictional element disposed on a surface of the weight.
3. The computer input pen of Claim 1, further comprising a frictional element disposed on an interior surface of the cylindrical housing.
4. The computer input pen of Claim 1, wherein the weight is rotationally coupled to a shaft extending along the longitudinal axis.
5. The computer input pen of Claim 4, further comprising a frictional element disposed on a surface of the weight relative to the shaft.
6. The computer input pen of Claim 4, further comprising a frictional element disposed on a surface of the shaft relative to the weight.
7. The computer input pen of Claim 1, further comprising a frictional element integrally formed on a surface of the weight.
8. The computer input pen of Claim 1, further comprising a frictional element integrally formed on an interior surface of the cylindrical housing.

17. A computer input pen, comprising:

means for moveably and eccentrically disposing a weight within a cylindrical housing; and;

means for providing a desired level of friction to absorb energy resulting from movement between the weight and the cylindrical housing.

18. The computer input pen of Claim 17, wherein the disposing means comprises means for rotationally disposing the weight within the cylindrical housing.

19. The computer input pen of Claim 17, wherein the friction means comprises means integrally formed on a surface of the weight.

20. The computer input pen of Claim 17, wherein the friction means comprises means integrally formed on an interior surface of the cylindrical housing.

21. The computer input pen of Claim 17, wherein the friction means comprises means formed on a shaft disposed along a longitudinal axis of the cylindrical housing and adapted to engage a corresponding surface of the weight.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None